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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,582	04/04/2002	Steve Vestergaard	119.5-US-WO	5988

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EXAMINER
TO, BAOTRAN N

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/980,582	VESTERGAARD ET AL.
	Examiner	Art Unit	
	Baotran N. To	2135	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 March 2006</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,11,17,18,20,21,25,27,28,31 and 33-46* is/are pending in the application.

    4a) Of the above claim(s) *7-10,12-16,19,22-24,26,29,30 and 32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,11,17,18,20,21,25,27,28,31 and 33-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

03/30/2006 has been entered.

This Office Action responds to the Applicant's Amendment filed on 03/30/2006.

Claims 1-6, 11, 17-18, 20-21, 25, 27-28, 31 and 33 are amended, Claims 7-10,.12-16,

19, 22-24, 26, 29, 30 and 32 are cancelled, and Claims 34-46 are new.

Claims 1-6, 11, 17-18, 20-21, 25, 27-28, 31 and 33-46 remain for examination.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-6, 11, 17-18, 20-21, 25, 27-28, 31,

33-46 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3.   Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply.

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention.

Claim 45 recites the limitation "the decryption key is performed without storing

the decrypted decryption key in memory accessible to a user of the user computing

device" which is not supported by the specification of the application.

4.   Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claim 45 recites the limitation " wherein using the user key to decrypt the

decryption key is performed without storing the decrypted decryption key in memory

accessible to a user of the user computing device " in lines 1-4. There is insufficient

antecedent basis for this limitation in the claim. It is unclear that the decryption key is

performed without storing it in memory (i.e., RAM, ROM). Applicant is required to

explain clearly about this limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 1, 3, 17, 21, 25, 36-39, 14-42 and 46 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Glover (U.S. Patent 6,052,780) herein referred to as Glover

and in view of Spies et al. (U.S. Patent 6,055,314) herein referred to as Spies.

        Regarding Claims 1 and 46, Glover discloses a method of distributing electronic

media, the method comprising:

        receiving a file (computer program) (col. 4, lines 30-35) at a user computing

device,

        the file comprising an integral decryption engine (decryption program) and

encrypted media content (encrypted digital information) (col. 3, lines 45-50 and col. 20,

lines 15-35),

        requesting a decryption key (key) from a remote server (content provider) (col. 3,

lines 45-50, col. 21, lines 20-65 and col. 22, lines 1-10); and

        responding to receipt of said decryption key from said remote server by:

decrypting said media content using said integral decryption engine and the decryption

key (col. 3, lines 45-50 and col. 21, lines 45-65).

        Glover explicitly does not disclose "receiving the decryption key from the remote

server, the decryption key itself encrypted with a user key, the user key bonded to the

user computing device by being based at least in part on one or more characteristics of

the user computing device such that the user computing device can use the user key to

decrypt the decryption key."

However, Spies clearly discloses receiving the decryption key from the remote server (col. 6, lines 55-58 and Figure 11, step 318), the decryption key itself encrypted with a user key (col. 8, lines 38-41 and Figure 11, step 320), the user key bonded to the user computing device by being based at least in part on one or more characteristics of the user computing device such that the user computing device can use the user key to decrypt the decryption key (col. 8, lines 35-57, col. 11, lines 40-45, and col. 14, lines 59-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Spies's invention with Glover to include receiving the decryption key from the remote server, the decryption key itself encrypted with a user key, the user key bonded to the user computing device by being based at least in part on one or more characteristics of the user computing device such that the user computing device can use the user key to decrypt the decryption key. One of ordinary skill in the art would have been motivated to prevent an individual from making a useful copy of the information (col. 2, lines 20-23 of Glover).

Regarding Claim 3, Glover and Spies disclose the limitations as discussed in Claim 1 above. Glover further discloses after decrypting the media content, viewing said media content by executing external viewer software linked to said file (col. 21, lines 20-60).

Regarding Claim 17, Glover discloses the limitations as discussed in Claim 35 above. Glover further discloses wherein the file is executable independently of other programs and wherein requesting the decryption key and decrypting the media content are accomplished by executing the file (col. 21, lines 45-50).

Regarding Claim 21, Glover discloses the limitations as discussed in Claim 3 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content locally (col. 6, lines 55-65).

Regarding Claim 25, Glover discloses the limitations as discussed in Claim 24 above. Glover further discloses wherein downloading the file from the second user comprises using a peer to peer network (col. 22, lines 10-20).

Regarding Claim 34, Glover and Spies disclose the limitations as discussed in Claim 1 above. Spies further discloses generating the user key at the user computing device prior to requesting the decryption key from the remote server (col. 11, lines 40-45) and wherein requesting the decryption key from the remote server comprises sending the user key from the user computing device to the remote server (col. 8, lines 25-41).

Regarding Claim 35, Glover and Spies disclose the limitations as discussed in Claim 34 above. Spies further discloses wherein decrypting the media content using the integral decryption engine and the decryption key comprises using the user key to decrypt the decryption key and to thereby obtain a decrypted decryption key (col. 16, lines 20-30).

Regarding Claim 36, Glover and Spies disclose the limitations as discussed in Claim 35 above. Spies further discloses wherein using the user key to decrypt the decryption key is performed without storing the decrypted decryption key in memory accessible to a user of the user computing device (col. 12, lines 22-30).

Regarding Claim 37, Glover and Spies disclose the limitations as discussed in Claim 35 above. Glover further discloses after decrypting the media content, viewing said media content by executing viewer software, the viewer software also integral with said file (col. 21 lines 1-45).

Regarding Claim 38, Glover and Spies disclose the limitations as discussed in Claim 36 above. Spies further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content in memory accessible to a user of the user computing device (col. 3, lines 35-50).

Regarding Claim 39, Glover and Spies disclose the limitations as discussed in Claim 37 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content in memory accessible to a user of the user computing device (col. 4, lines 30-65).

Regarding Claim 40, Glover and Spies disclose the limitations as discussed in Claim 35 above. Glover further discloses previewing a previewable portion of the media content prior to decrypting the media content using the integral decryption engine and the encryption key.

Regarding Claim 41, Glover and Spies disclose the limitations as discussed in Claim 35 above. Spies further discloses wherein receiving the file at the user computing device comprises downloading the file using a peer to peer network (col. 3, lines 5-18).

Regarding Claim 42, Glover and Spies disclose the limitations as discussed in Claim 1 above. Spies further discloses wherein decrypting the media content using the integral decryption engine and the decryption key comprises using the user key to decrypt key and to thereby obtain a decrypted decryption key (col. 6, lines 55-65) and wherein using the user key to decrypt the decryption key is performed without storing the decrypted decryption key in memory accessible to a user of the user computing device (col. 12, lines 22-30).

2.   Claims 4-6, 11, 28, 31 and 43-45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Glover (U.S. Patent 6,052,780) herein referred to as Glover in view of

Budge et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge and further in view

of Spies et al. (U.S. Patent 6,055,314) herein referred to as Spies.

Regarding Claim 4, Glover discloses a method of managing distribution of

proprietary electronic media, the method comprising:

receiving a single file (computer program) at a user computing device (col. 4,

lines 30-35), the file comprising an integral decryption engine and encrypted media

content (encrypted digital information) (col. 3, lines 45-50), but Glover explicitly does not

disclose "integral media playback software."

However, Budge expressly discloses integral media playback software (col. 2,

lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated Glover's invention with Budge to

provide integral media playback software. One of ordinary skill in the art would have

been motivated to allow the receiving system to view the video file without necessity of

previously installing special software at the receiving system (col. 6, lines 15-20).

Glover and Budge disclose the limitations of Claim 4 above. Furthermore, Glover

discloses the single file executable independently of other program to:

decrypt the media content using the integral decryption engine and a decryption

key obtained separately from the file (col. 3, lines 45-50 and col. 21, lines 20-65); and

Budge explicitly discloses view the media content using the integral media playback

software (col. 6, lines 15-20).

Glover and Budge explicitly do not disclose "receiving the decryption key from

the remote server, the decryption key itself encrypted with a user key, the user key

bonded to the user computing device by being based at least in part on one or more

characteristics of the user computing device such that the user computing device can

use the user key to decrypt the decryption key."

However, Spies clearly discloses receiving the decryption key from the remote

server (col. 6, lines 55-58 and Figure 11, step 318), the decryption key itself encrypted

with a user key (col. 8, lines 38-41 and Figure 11, step 320), the user key bonded to the

user computing device by being based at least in part on one or more characteristics of

the user computing device such that the user computing device can use the user key to

decrypt the decryption key (col. 8, lines 35-57, col. 11, lines 40-45, and col. 14, lines 59-

63).

Accordingly, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated Spies's invention with Glover and

Budge to include receiving the decryption key from the remote server, the decryption

key itself encrypted with a user key, the user key bonded to the user computing device

by being based at least in part on one or more characteristics of the user computing

device such that the user computing device can use the user key to decrypt the

decryption key. One of ordinary skill in the art would have been motivated to prevent an

individual from making a useful copy of the information (col. 2, lines 20-23 of Glover).

Regarding Claim 5, Glover, Budge and Spies disclose the limitations as

discussed in Claim 4 above. Glover further discloses wherein downloading the single

file comprises downloading said single file from a remote server via a communication

network (col. 21, lines 5 and col. 22, lines 15-20).

Regarding Claim 6, Glover, Budge and Spies disclose the limitations as

discussed in Claim 5 above. Glover further discloses downloading said decryption key

from said remote server via said communication network (col. 21, lines 60-65 and col.

22, lines 1-10).

Regarding Claim 11, Glover, Budge and Spies disclose the limitations as

discussed in Claim 6 above. Glover further discloses wherein said remote server tracks

a number of decrypting key downloads relating to the single file (col. 21, lines 5-10).

Regarding on Claim 28, Glover, Budge and Spies disclose the limitations as

discussed in Claim 4 above. Glover further discloses wherein the single file is

executable to view the media content using the integral media playback software

without storing a decrypted copy of the media content in memory accessible to a user of

the user computing device (col. 20, lines 55-67).

Regarding Claim 31, Glover, Budge and Spies disclose the limitations as

discussed in Claim 4 above. Glover further discloses wherein server tracks a number of

decryption key downloads relating to the single file (col. 21, lines 5-10).

Regarding Claim 43, Glover, Budge and Spies disclose the limitations as

discussed in Claim 4 above. Spies further discloses wherein execution of the single file

causes the user computing device to generate the user key and to communicate the

user key to remote server (col. 15, lines 60-67).

Regarding Claim 44, Glover, Budge and Spies disclose the limitations as

discussed in Claim 43 above. Spies further discloses wherein execution of the single

file to decrypt the media content using the integral decryption engine and the decryption

key comprises using the user key to decrypt the decryption key and to thereby obtain a

decrypted decryption key (col. 16, lines 20-30).

Regarding Claim 45, Glover, Budge and Spies disclose the limitations as

discussed in Claim 44 above. Spies further discloses wherein using the user key to

decrypt the decryption key is performed without storing the decrypted decryption key in

memory accessible to a user of the user computing device (col. 12, lines 22-30).

3.   Claims 2, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Glover as applied to claim 1 above, and further in view of Glover in view of Budge

et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge.

Regarding Claim 2, Glover and Spies disclose the limitations as discussed in

Claim 1 above. Glover further discloses after decrypting the media content (col. 3, lines

45-50), but Glover and Spies explicitly do not disclose viewing said media content by

executing viewer software, the viewer software also integral with said file.

However, Budge expressly discloses viewing said media content by executing

viewer software, the viewer software also integral with said file (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated Budge's invention within Glover and

Spies to provide viewing said media content by executing viewer software, the viewer

software also integral with said file. One of ordinary skill in the art would have been

motivated to allow the receiving system to view the video file without necessity of

previously installing special software at the receiving system (col. 6, lines 15-20).

Regarding Claim 18, Glover and Spies disclose the limitations as discussed in

Claim 17 above. Glover and Spies do not disclose wherein the file also comprises

integral media player software.

However, Budge expressly discloses wherein the file also comprises integral

media player software (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Budge's invention within Glover and Spies to provide wherein the file also comprises integral media player software. One of ordinary skill in the art would have been motivated to allow the receiving system to view the video file without necessity of previously installing special software at the receiving system (col. 6, lines 15-20).

Regarding Claim 20, Glover Spies and Budge disclose the limitations as discussed in Claim 2 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content locally (col. 20, lines 55-67).

4.   Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glover, Budge and Spies as applied to claim 4 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding Claim 33, Glover, Budge and Spies disclose the limitations as discussed in Claim 4 above. Glover, Budge and Spies explicitly do not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention within Glover, Budge and Spies to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

5.   Claims 27 and 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glover and Spies as applied to claims 1 and 35 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding Claims 27 and 40, Glover and Spies disclose the limitations as discussed in Claim 4 above. Glover and Spies explicitly do not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention within Glover and Spies to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

Prior Art

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ignazewski (U.S. Patent 6,674,297 B1)

Gruse et al. (U.S. Patent 6,389,538 B1)
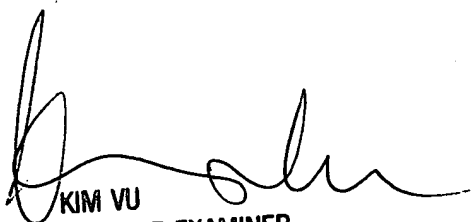
Contact Information

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baotran N. To whose telephone number is 571-272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Baotran To
05/12/2006

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